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Jerold Shan

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04/01/2009

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FORT COLLINS, CO 80527-2400

EXAMINER

AUGUSTIN, EVENS J

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

04/01/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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6 UNITED STATES PATENT AND TRADEMARK OFFICE
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9 BEFORE THE BOARD OF PATENT APPEALS
10 AND INTERFERENCES
11

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13 *Ex parte* JEROLD SHAN and DIRK BEYER
14

15 Appeal 2009-1100
16 Application 09/852,611
17 Technology Center 3600
18

19
20 Decided: ¹ March 30, 2009
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23 *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH
24 A. FISCHETTI, *Administrative Patent Judges.*

25
26 CRAWFORD, *Administrative Patent Judge.*
27

28 DECISION ON APPEAL
29
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¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304 (2008), begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or the Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1, 4, 6 to 10, 13, 15 to 35 and 37 to 42. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented an online shopping conversion simulation module for predicting the chance of an online shopper being converted into becoming an actual purchaser of an item based on sales promotions offered by an online vendor (Specification 1, 3).

Claim 1 under appeal reads as follows:

1. A method for predicting whether an on-line shopper will be converted into becoming a purchaser of an item based on sales promotions offered by an on-line vendor, comprising the steps of:

storing customer profile information corresponding to a plurality of on-line shoppers;

storing customer web log information corresponding to the plurality of on-line shoppers;

storing promotion attributes corresponding to a plurality of sales promotions that have been offered;

inputting the customer profile information, the web log information and the promotion attributes into a model for simulating shopping behavior as a function of the customer profile information and the promotion attributes; and

offering promotions based on the model.

The Examiner rejected claims 1, 10, 19 to 25, 27 to 33, 35 and 37 to 40 under 35 U.S.C. § 102(e) as being anticipated by Gerace,

1 The Examiner rejected claims 4, 6 to 9, 13, 15 to 18, 26, 34, 41 and 42
2 under 35 U.S.C. § 103(a) as being unpatentable over Gerace.²

3 The prior art relied upon by the Examiner in rejecting the claims on
4 appeal is:

5 Gerace 5,848,396 Dec. 8, 1998

6
7 ISSUE

8 Do the appealed claims comply with the requirements of 37 C.F.R.
9 § 112, second paragraph?

10
11 FINDINGS OF FACT

12 Appellants disclose a method for predicting shopping behavior by
13 storing sales promotion attributes of sales promotions offered and inputting
14 these sales promotion attributes into a model for simulating shopping
15 behavior (Specification 3). Appellants define a “promotion” as “a set of
16 attributes” (Specification 9).

17 An attribute is a characteristic or quality inherent in something.
18 *Merriam-Webster Online Dictionary* available at [http://www.merriam-
webster.com](http://www.merriam-
19 webster.com) (last visited March 29, 2009).

20 PRINCIPLES OF LAW

21 The second paragraph of 35 U.S.C. § 112 requires claims to set out
22 and circumscribe a particular area with a reasonable degree of precision and
23 particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In making

² The Examiner’s rejections under 35 U.S.C. § § 112 and 101 have been withdrawn (Answer 3).

1 this determination, the definiteness of the language employed in the claims
2 must be analyzed, not in a vacuum, but always in light of the teachings of
3 the prior art and of the particular application disclosure as it would be
4 interpreted by one possessing the ordinary level of skill in the pertinent art.
5 *Id.*

6 As the court in *In re Wilson*, 424 F.2d 1382 (CCPA 1970) stated:
7

8 All words in a claim must be considered in judging the
9 patentability of that claim against the prior art. If no
10 reasonably definite meaning can be ascribed to certain
11 terms in the claim, the subject matter does not become
12 obvious --the claim becomes indefinite.
13

14 ANALYSIS

15 New rejection

16 Pursuant to 37 CFR § 41.50(b) we make the following new rejection.
17 Claims 1, 4, 6 to 10, 13, 15 to 35 and 37 to 42 are rejected under 35 U.S.C.
18 § 112, second paragraph, as being indefinite for failing to particularly point
19 out and distinctly claim the subject matter which the appellants regard as the
20 invention.

21 In two paragraphs of the claim, claim 1 recites “promotion
22 attributes.” As the Specification at 9 defines a promotion as a set of
23 attributes, claim 1 is in effect reciting “a set of attributes attributes.” It is not
24 understood what a “set of attributes attributes” is, and one of ordinary skill
25 would be unable to discern the metes and bounds of the claim as a result.
26 An attribute is a characteristic of something, the claim is reciting a set of
27 characteristics characteristics. In addition, claim 1 recites that the sales

1 promotions “have been offered.” It is unclear how attributes or
2 characteristics can be offered.

3 As the recitation of “promotion attributes” is indefinite for being not
4 clear to one of ordinary skill and as it is not understood how an attribute can
5 be offered, claim 1 is not in compliance with the requirements of 35 U.S.C.
6 § 112, second paragraph.

7 Independent claims 10 and 35 also recite “promotion attributes” and
8 that the promotion attributes have been/were offered and are likewise not in
9 compliance with 35 U.S.C. § 112, second paragraph.

10
11 *Prior Art rejections*

12 In comparing the claimed subject matter with the applied prior art,
13 it is apparent to us that considerable speculations and assumptions are
14 necessary in order to determine what in fact is being claimed. Since
15 a rejection based on prior art cannot be based on speculations and
16 assumptions, *see In re Steele*, 305 F.2d 859, 862 (CCPA 1962), we are
17 constrained to reverse, *pro forma*, the Examiner's rejections of claims 1, 4, 6
18 to 10, 13, 15 to 35 and 37 to 42 under 35 U.S.C. §§ 102 and 103. We hasten
19 to add that this is a procedural reversal rather than one based upon the merits
20 of the rejections.

21 **CONCLUSION OF LAW**

22 The rejections of the Examiner under 35 U.S.C. §§ 102 and 103 are
23 not sustained.

24 This Decision contains a new rejection within the meaning of 37
25 C.F.R. § 41.50(b) (2007). Our decision is not a final agency action.

1 37 CFR § 41.50 (b) also provides that the appellant, WITHIN TWO
2 MONTHS FROM THE DATE OF THE DECISION, must exercise one of
3 the following two options with respect to the new ground of rejection to
4 avoid termination of the appeal as to the rejected claims:

5 (1) Reopen prosecution. Submit an appropriate amendment of the
6 claims so rejected or new evidence relating to the claims so rejected, or
7 both, and have the matter reconsidered by the examiner, in which event the
8 proceeding will be remanded to the examiner

9 (2) Request rehearing. Request that the proceeding be reheard under §
10 41.52 by the Board upon the same record

11 Should the appellant elect to prosecute further before the examiner
12 pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek
13 review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,
14 the effective date of the affirmance is deferred until conclusion of the
15 prosecution before the examiner unless, as a mere incident to the limited
16 prosecution, the affirmed rejection is overcome.

1 If the Appellant elects prosecution before the Examiner and this does
2 not result in allowance of the application, abandonment or a second appeal,
3 this case should be returned to the Board of Patent Appeals and Interferences
4 for final action on the affirmed rejection, including any timely request for
5 rehearing thereof.

6 REVERSED; 37 CFR § 41.50

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